

REMARKS

The present amendment is in response to the Office Action dated March 14, 2005, where the Examiner rejected claims 1-40. Claims 6, 16, 26, and 36 were rejected for indefiniteness. Claims 1-7, 11-17, 21 -27, and 31-37 were rejected on 102(b) grounds. Claims 8-10, 18-20, 28-30, and 38-40 are rejected on 103(a) grounds.

A. Specification

The Examiner has identified two informalities in his Office Action. The informalities have been corrected as described in the Amendment to the Specification.

B. Claim Rejections – 35 USC § 112

The Examiner has rejected claims 6, 16, 26 and 36 for insufficient antecedent basis for the limitation “said downstream modulator.”

The Applicant has corrected this defect by amending claims 6, 16, 26 and 36 to depend on claims 2, 12, 22, and 32, respectively. The Examiner shall appreciate that claim 2, 12, 22, and 32 have been amended to include the appropriate antecedent basis for the “downstream QAM modulator.”

C. Claim Rejections – 35 USC § 102

The Examiner has rejected claims 1-7, 11-17, 21 -27, and 31-37 under 35 USC 102(b) grounds as being anticipated by Hylton et al., U.S. Patent 5,708,961 hereinafter referred to as “Hylton ‘961.” Although, the Applicant disagrees with Examiner, the Applicant has amended the claims to expedite the prosecution of this patent application.

The Federal Circuit stated in W.L. Gore & Associates v. Garlock, Inc., “anticipation requires the disclosure in single prior art reference of each element of the claim under consideration.” W.L. Gore & Associates v. Garlock, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Amended independent claims 1, 11, 21 and 31 reflect the addition of a substantive limitation that comprises a digital headend which is communicatively coupled to the bus interface. Applicant has reviewed the Hylton ‘961 reference, which is directed to “Wireless On-Premises Distribution Using Digital Multiplexing.” See Title of Hylton ‘961. In particular Hylton ‘961 is directed to providing wireless distribution of digital broadband information within a customer premises. Hylton ‘961 does NOT teach a digital headend system. Thus, Applicant contends that there is no anticipation because Hylton ‘961 is directed to completely different use.

Additionally, the Applicant claims a bus interface that is configured to be communicatively coupled to a digital headend. The Hylton ‘961 patent does not *expressly* teach a bus interface. In fact the Examiner states that the Hylton ‘961 “input interface from the broadband network 5 into the shared processing system 10 *is interpreted* to act as a bus interface.” See Page 3 of Examiner’s Office Action (emphasis added). Thus, the Examiner is not relying on an express disclosure from Hylton ‘961 to describe the Applicant’s the “bus interface” element.

It appears that by “interpreting” Hylton ‘961, the Examiner is arguing “inherency” without providing extrinsic evidence.

To serve as anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would so recognized by the person of ordinary skill in the art. Continental Can Co. USA v. Monsanto, Co., 948 F. 2d 1264, 20 USPQ2d 1749, 1749-1750 (Fed. Cir. 1990)

For purposes of expediting the prosecution of this patent application, the Applicant will assume that the Examiner's interpretation of Hylton '961 is based on an inherent characteristic that would be recognized by those of ordinary skill in the art.

As amended, the Applicant's bus interface is configured to be communicatively coupled to the digital headend. However, Hylton '961 (at col. 5: line 42-44) discloses receiving a plurality of channels from the network, in which the network is a hybrid fiber-coax network, switched digital video type fiber to the curb network, and wireless digital broadcast network (Hylton '961 at col. 5: line 12-15). Applicant respectfully submits that Applicant's amended bus interface is substantially different from the Hylton '961 network connection.

Thus, the Applicant submits that with respect to amended independent claims 1, 11, 21 and 31, each of these amended independent claims overcomes the 35 USC 102 rejection. Since the remaining dependent claims depend on each of these independent claims, the Applicant submits these dependent claims also overcome the 102 rejection.

In spite of not presenting an argument for each dependent claim, the Applicant reserves the right to respond to these objections at a later time. The Applicant respectfully submits that Applicant's rights are not prejudiced by failing to respond to the objections presented for each of the dependent claims identified above. Should the Examiner require a response to each of the dependent claims in view of the arguments propounded for each independent claim, Applicant respectfully requests such instruction.

D. Claim Rejections – 35 USC § 103

The Examiner has rejected claims 8-10, 18-20, 28-30, and 38-40 on 103(a) grounds. The Examiner argues non-obviousness over Hylton '961 in view of Chen et al., U.S. Patent No. 5,666,362 (hereinafter "Chen '362"). In light of the currently amended claims, the Applicant respectfully disagrees with this rejection and provides arguments to overcome this rejection below.

The Examiner's arguments are directed to dependent claims which depend from the independent claims 1, 11, 21, and 31. As described above, the independent claims have been amended.

As stated in Section 2143 of the MPEP:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Section 2143, MPEP Rev. 2.0, May 2004, pg. 2100-129.

The combination of Hylton '961 in view of Chen '362 does not teach a processor that is operatively coupled to a bus interface which is communicatively coupled to a digital headend. Thus, Hylton '961 and Chen '362 fail to satisfy the 35 USC 103 obviousness standard because both patents fail to teach each element of the amended independent claims.

In view of the amendments and argument, Applicant contends the dependent claims 8-10, 18-20, 28-30, and 38-40 should be found to be in a state of allowance because they depend on independent claims 1, 11, 21, and 31.

E. Conclusion

For all the foregoing reasons, allowance of claims 1-40 pending in the present application is respectfully requested.

Respectfully Submitted;

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Michael A. Kerr
Patent Attorney
Reg. No. 42,722

Michael A. Kerr
VIRTUAL LEGAL, P.C.
777 E. William St., Ste. 211
Carson City, NV 89701
Tel: (775) 841-3388
Fax: (775) 841-3389